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10/775,195	02/11/2004	Daniel Willis	165-05 US CIP	1626

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EXAMINER
OMOTOSHO, EMMANUEL

ART UNIT	PAPER NUMBER
3714	

NOTIFICATION DATE	DELIVERY MODE
10/02/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

	Application No.	Applicant(s)
	10/775,195	WILLIS, DANIEL
Office Action Summary	Examiner	Art Unit	
	EMMANUEL OMOTOSHO	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 September 2008</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-31,33 and 35-39</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-31,33 and 35-39</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
         application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>9/3/08</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

          Office Action Summary

DETAILED ACTION

Examiner's Note

It is highly recommended, in addition to the next applicant response to the office,

that the applicant clarifies the meaning of "client instruction data", "set top client

instruction data", and "set top game instruction data". Is "client instruction data" data

relating to the identity of the client (i.e. password/username), or is it the data relating to

the inputs provided by the client through the input device (i.e. client presses start button

on the game controller)? How is the set top client instruction data different from the

client instruction data? The specification, on page 7, mentions that client instruction

data and gaming instruction data could be of the same dataset, however, the current

claim language as currently claimed and the current specification as filed shed no light

on what the dataset is referring to.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4.   Claims 1-2,6-39 are rejected under 35 U.S.C. 102(b) as being anticipated by

Yamada US Patent No. 6,929,549 B1.

Yamada teaches a digital television set system comprising:

5.   Claim 1: a receiver for receiving digital television signals from at least a

communication channel and a gaming console for use as a gaming client, the gaming

console connected to the receiver (Col 7 lines 8-19, 40-46). A volatile storage memory for having stored therein client instruction data relating to a gaming client and game instruction data relating to a current game in execution (Col 23 line 63- Col 24 line 24, Col 24 lines 19-24). An external storage medium reading circuit for sensing data from an external storage medium and for storing the received data in the at least a volatile storage medium (Col 14 lines 34-40, Col 23 line 63- Col 24 line 24, Col 24 lines 19-24). A processor in communication with the volatile storage medium, the processor operable to retrieve the game instruction data therefrom and to execute the game instruction data to execute a game on the gaming console (**Col 20:41-56**), and operable to retrieve client instruction data therefrom and to execute the client instruction data to execute a gaming client function on the gaming console (**Col 20:41-56, i.e. the gaming console uses the gaming clients credentials to connect to the gaming provider server through a modem**) wherein the volatile storage medium further comprises set-top client instruction data and set-top application instruction data (**Col 19:11-64**), and wherein the processor is further operable to retrieve the set top client instruction data and the set top application instruction data from the volatile storage medium and operable to execute the set top client instruction data and the set top application game data to emulate a set-top box on the gaming console, including extracting video information from digital television signals and displaying the extracted video information (**Col 19:11-64**, Fig 3-5, 8-11, **the gaming console's processor is also connected to an MPEG decoder, audio decompressor and signal demodulators**).

6.   Claim 2: an external local storage medium wherein the client instruction data and game instruction data are loaded from the external local storage medium into the at least a volatile storage medium (Col 13 lines 42-50, line 65 – Col 14 line 6, Col 15 lines 9-42 and Col 8 lines 59-63).

7.   Claim 5: a transceiver for establishing a connection to a broadband access network and wherein the set top client instruction data and the set top application instruction data are received from the broadband access network and loaded into the volatile storage medium (Col 3 lines 9-19, Col 7 lines 8-19, 40-46).

8.   Claim 6, 22, 33-37: a gaming console being part of digital television set system and coupled to a receiver for receiving digital television signals from at least a communication channel, the gaming console comprising at least a processor and at least a storage medium, and being in connection with a monitor and a sound system (Col 7 lines 8-19, 40-46,). Receiving set-top instruction data for emulating a set top box. Executing the set-top box instruction data on the gaming console to emulate a set top box on the gaming console, including, receiving encoded digital broadcast data via the receiver, decoding the received, encoded digital broadcast data on the gaming console and displaying the decoded digital broadcast data on the monitor and on the sound system (Col 10 lines 20-52).

9.   Claims 7-8: the set top instruction data are received from the receiver and an external storage medium in connection with the gamin console (Col 10 lines 20-31)

10.   Claim 9, 23: receiving a conditional access module and verifying access
authorization for encoded digital broadcast data with the conditional access module (Col
25 lines 17-23).

11.   Claim 10, 24: wherein the access authorization is verified using authorization
data provided from a smart card, the smart card in connection with the gaming console
through an interface (Col 25 lines 17-23).

12.   Claim 11, 25: encoded digital broadcast data are scrambled, encoded digital data
(Col 9 lines 32-37).

13.   Claim 12, 26: the scrambled, encoded digital broadcast data is descrambled by
the conditional access module before being decoded (Col 14 lines 46-54).

14.   Claim 13, 27: wherein the gaming console is in communication with a monitor
and is emulating a set top box for receiving and displaying on the monitor, services
other than gaming services (Col 25 line 62- Col 26 line 9).

15.   Claims 19-21, 28-31: wherein the services relate to digital television broadcast,
transmission control protocol/internet protocol access, or interactive television
applications (Col 25 line 62- Col 26 line 9).

16.   Claim 32, 34: wherein the first network and the second network are the same (fig.
4, i.e. the network of the entertainment system is one)

Claim Rejections - 35 USC § 103

17.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

18.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

    1.   Determining the scope and contents of the prior art.
    2.   Ascertaining the differences between the prior art and the claims at issue.
    3.   Resolving the level of ordinary skill in the pertinent art.
    4.   Considering objective evidence present in the application indicating
            obviousness or nonobviousness.

19.   Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Yamada.

20.   Claims 3-4: Yamada fail to specifically disclose that the external storage medium

is a compact disc/removable read-only memory cartridge. Applicant did not disclose

that choosing a compact disc/removable read-only memory cartridge as the memory

medium for an external local storage medium provides an advantage, used for a

particular purpose or solves a stated problem. Yamada teaches that the information is

capable of being stored on a removable memory (Col 14 lines 62-67). Therefore, the

examiner views this limitation of choosing between different types of memory mediums

as a mere design choice well within the skill set of an ordinary skilled artisan.

21.   Claim 14: Yamada teaches wherein the monitor is a monitor included in an

analog transmission television set for a gaming machine with an analog transmission

television set (Col 21 lines 45 - 67)

22.   Claims 15-18: In the second embodiment, Yamada teaches that the gaming

console is in communication with at least another network such as a community

antenna television network, a telephone line network or a wireless network to solve the
problem of the obstructive connection of the devices in the first embodiment (Col 25 line
62- Col 26 line 9, Col 17 lines 53-62).

23.   **Claim 38-39: Yamada teach a method for emulating a set-top box**
comprising: providing a gaming console (figs 1-2b), comprising a processor (fig
3), a gaming controller (fig 3), and a storage medium (fig 24-2b), and supporting
communication with one or more networks (fig 1-3), a monitor and a sound
system (fig 2a-3), the storage medium having stored therein a gaming client (col
9:25-33); initializing the gaming client to establish communication with a network
and to receive instruction data from the network (col 10:48-57), the instruction
data being one of game instruction data for running a game when executed on
the gaming console (col 20:41-47) and set-top instruction data for emulating a
set-top box when executed on the gaming console (Col 19:11-24, Col 20:14-34, for
example, MPEG decoding instruction executed by the gaming console processor
could serve as the set top game instruction data); and if the received instruction
data is game instruction data: executing the game instruction data on the game
console to run an associated game (col 20:41-47); and if the received instruction
data is set-top instruction data: executing the set-top instruction data on the
gaming console to emulate a set-top box(Col 19:11-24, Col 20:14-34), including:
receiving encoded digital broadcast data from the network; decoding the
received, encoded digital broadcast data; and displaying the decoded digital

broadcast data on the monitor and on the sound system (Col 19:11-24, Col 20:14-34).

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a. Knee et al. US Patent 5,589,892 – Teaches a gaming system that also functions as a set-top box.

b. Naiff US Patent 5,982,363 – Teaches a personal computer that provides the functions of a set-top box.

Response to Arguments

1.   Applicant's amendments filed 1/9/08 are sufficient enough to overcome the objection to the drawings and the rejection under 35 U.S.C. 112 second paragraph. The objection and rejection has been withdrawn.

2.   Applicant's arguments filed 1/9/08 have been fully considered but they are not persuasive.

3.   On page 14, applicant argues, "Yamada discloses a system with a game machine, a set-top box that is distinct from the game machine, and a TV. Yamada does not disclose that the game machine or a processor thereof is operable to execute set,top instructions to extract video signals from digital satellite broadcast signals and to display the information in the video signals. The functionality of extracting video signals

from digital satellite broadcast signals remain with the set-top box. Additionally, Yamada

does not disclose that its set-top box or a processor thereof is operable to execute

game software; the set-top box downloads and stores the game software and provides

the game software to the game machine for execution."

4.   The examiner respectfully disagrees. As can be seen in col 8:26-61, it is the

gaming system's CPU that **executes instructions to** connect to the network, to extract

video signals and to run the game software. In other words, it is the gaming system's

processor that signals the system to connect to the network, extract video signals and

run the game software.

5.   On page 15, applicant argues, "Yamada does not disclose that the game

machine, the set-top box, or the television receiver receives from external storage set-

top instruction data or communication data for retrieving the set-top instruction data.

The game machine in Yamada can receive game software from the set-top box, but

Yamada does not disclose that the game machine can receive set-top instruction data

for decoding digital broadcast signals or communication data for retrieving set-top

instruction data. In Yamada, the digital broadcast signal decoding functionality is not

associated with the game console. Thus, Yamada does not anticipate claim 6. This

rejection should be withdrawn."

6.   The examiner respectfully disagrees. The current claim language calls for "set-

top instruction data **for** receiving and decoding digital broadcast data" and

"communication data **for** use in retrieving via the receiver the set top instruction data for

receiving and decoding digital broadcast data". The 'selection control signal' taught by

Yamada in (Col 7 lines 8-19, 40-46) meets these limitation since this data is needed for
the receiving, decoding and communicating process to begin.

Response to Arguments

7.   Applicant's arguments filed 7/14/08 have been fully considered but they are not
persuasive.

8.   On page 12, applicant argues, "The Applicant respectfully submits that Yamada
does not disclose or suggest this feature. Yamada discloses a game machine and a set-
top box. The set-top box receives game software information from a game provider in a
digital satellite broadcasting signal, and descrambles the signal to store the game
software information, The set-top box sends the game software to the game machine
for execution at the game machine. The game machine performs its expected functions
(e.g., executing game software) and the set-top box performs its expected functions
(e.g., receiving, descrambling, and storing game software information). Yamada does
not disclose or suggest that the game machine runs instructions that the game machine
treats as typical game instructions but which actually makes the game machine emulate
a set-top box. Likewise, though not relevant to this discussion, Yamada does not
disclose or suggest that the set-top box runs instructions that the set-top box treats as
typical set-top box instructions but which makes the set-top box emulate the game
machine. Thus, claim 1 is not anticipated by Yamada."

9.   Examiner respectfully disagrees. Please see newly expanded par 5 and 23
above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMMANUEL OMOTOSHO whose telephone number is (571)272-3106. The examiner can normally be reached on m-f 10-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EO

/Ronald Laneau/
Primary Examiner, Art Unit 3714
09/26/08